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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,892	06/29/2001	Hideaki Ono	50195-261	4949

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EXAMINER
SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 07/28/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/893,892	Applicant(s) ONO ET AL.	
	Examiner John P. Sheehan	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-12 and 14-19* is/are pending in the application.

4a) Of the above claim(s) *5-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. This application contains claims 5 to 12 drawn to an invention nonelected with traverse in Paper No. 3

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claim 14, lines 11 and 12, the meaning of the phrase, "a content of amorphous parts of magnetization of 95% or less" is not clear. What does this phrase mean? Those skilled in the art would not understand what is claimed even when the claims are read in light of the specification. Do applicants intend that the amorphous parts of the crystalline mother material is less than 95% or less as disclosed at page 8, lines 18 to 20 of the specification? If this is the case, then this rejection can be overcome by deleting the word, "magnetization".

Claim R jections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14 to 19 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nomura et al. (Nomura, US Patent No. 6,261,385).

Nomura teaches an anisotropic nanocomposite rare earth permanent magnet consisting of a hard magnetic phase and a soft magnetic phase (column 3, lines 28 to 35). Nomura teaches that the hard magnetic phase contains a rare earth metal, a transition metal and nitrogen or boron (column 3, lines 60 to 68) and the soft magnetic phase can contain at least one transition metal and boron or nitrogen (column 4, lines 3 to 8). Nomura teaches that the hard magnetic phase can contain at least one rare earth, a transition metal and N or B (column 4, lines 37 to 43) and that the soft magnetic

phase can contain a transition metal and B (column 4, lines 48 to 51). These hard and soft magnetic phases taught by Nomura are encompassed by the instant claim language used to claim the hard and soft magnetic phases recited in the instant claims. Nomura defines the crystal size of a nanocomposite as being "several tens of nanometers" (column 2, lines 40 to 45) which overlaps the crystal size range of "150 nm or less" recited in the instant claims. Nomura also teaches preferred combination of phases that are encompassed by the instant claims (column 4, line 60 to column 5, line 3). Nomura teaches that this magnetic material can be ground to form an anisotropic nanocomposite powder (column 8, lines 1 to 5). Finally, Nomura teaches specific example alloys that are encompassed by the instant claims (column 9, Examples 2 to 6).

The claims and Nomura differ in that Nomura does not teach the process steps recited in the claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the process limitations recited in the instant product by process claims do not necessarily lend patentability to the claimed product, MPEP 2113.

Response to Arguments

Applicants' arguments submitted July 7, 2003 have been considered by the Examiner but have been found non-persuasive.

Applicants, referring to Figures 1 to 4, 7 to 10 and 12 and various statements in the specification argue,

> "that the claimed product-by-process has both novelty and inventive step (in the following steps of the present invention:
>
> (1) preparing step the crystalline mother material having a content of amorphous magnetization of 95% or less,
>
> (2) repeating a continuous process composed of said amorphising process and crystallizing process, one or more times."

And that, "Nomura does not disclose of (sic) suggest the...features and effects of the present product-by-process claims" (applicants' response pages 6 and 7).

The Examiner is not persuaded. As set forth in the statement of the rejection the process limitations recited in applicants' product by process claims do not necessarily lend patentability to the instantly claims product, MPEP 2113. The sections of the specification cited by applicants in their arguments are not data in support of applicants' position but rather are merely unsubstantiated statements. "It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification do not suffice." In re Deblauwe, 222 USPQ 191, 196 (Fed. Cir. 1984). Mere lawyer's arguments and conclusory statements in the specification, unsupported by objective evidence, are insufficient to establish unexpected results", In re Wood, Whittaker, Stirling and Ohta, 199 USPQ 137, 140 (CCPA 1978). With respect to applicants' referral to Figures 1 to 4, 7 to 10 and 12 of the specification it is the Examiner's position that applicants general reference to these

figures in the specification with no explanation of what facts or data applicants are relying on and what the data allegedly establishes is not persuasive, In re Borkowski 184 USPQ 29. Further, these figures do not compare applicants' claimed invention to the closest prior art, Nomura and therefore do not establish that applicants' claimed invention distinguishes over Nomura, MPEP 716.02(e). Finally, all the data set forth in these figures is disclosed as relative values. It is not clear what this means, relative to what?

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

John P. Sheehan
Primary Examiner
Art Unit 1742

jps
July 24, 2003